

REMARKS

Entry of the foregoing amendment is respectfully requested. The amendment is believed to place the application in condition for allowance and is, therefore, appropriate under Rule 11b. The amendment does not raise any new issue and thus does not require any additional search by the Examiner.

The amendment was not previously presented because a formal error in claim 3 was not noticed until pointed out by the Examiner.

With the present amendment, claim 3 is amended to provide it with a proper identifier.

Based on the foregoing amendment and the following remark, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as unpatentable over Guzzella (5,584,679) in view of Steffen (6,123,158) in further view of Moolenaar et al. (5,385,572). It is respectfully submitted that claims 1 and 3-5 are patentable over the combination set forth in the Office action.

Specifically, claim 1 recites a strictly mechanical rpm-dependent clutch in the force-transfer path between the electric motor and the transmission for transmitting torque from the electric motor to the transmission. No such clutch is disclosed in the prior art applied for rejection of the claims.

Considering the prior art, Guzzella discloses a pure electromagnetic clutch (5). The difference between an electromagnetic clutch, which is controlled by the motor-controlled electronics, and a strictly mechanical rpm-dependent clutch consists in that the mechanical, rpm-dependent clutch is self-controlled (see the paragraph bridging pages 4-5 of the specification). While Guzzella may contemplate use of a mechanical clutch, nowhere is it disclosed that such a clutch is rpm-dependent. Moreover, a pure mechanical rpm-dependent clutch would be incompatible with an intended operation of the control system of Guzzella.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art referenced (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the third criterium of *prima facie* obviousness has not been established.

In view of the above it is respectfully submitted that the combination of Guzella, Steffen, and Moolenaar does not make the present invention as defined by claim 1 obvious, and claim 1 is patentable over said combination and is allowable.

Claim 3 depends on claim 1 and is allowable as being dependent on an allowable subject matter.

Claim 4 relates to a method of operating the tool of claim 1, relies for its patentability on the same inventive features as claim 1 expressed in method form language, and is allowable for the same reasons claim 1 is allowable.

Claim 5 depends on claim 1 and is also allowable.

CONCLUSION

In view of the foregoing it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by an Examiner's amendment and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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